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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/747,529	12/22/2000	James M. Sheppard JR.	2827	2077

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EXAMINER

BEFUMO, JENNA LEIGH

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 01/23/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/747,529

Applicant(s)

SHEPPARD, JAMES M.

Examiner

Jenna-Leigh Befumo

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 October 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 1771

DETAILED ACTION

Response to Amendment

1. Amendment A, submitted as Paper No. 6 on November 20, 2002, has been entered. Claims 1 – 20 have been cancelled. Claims 21 – 36 have been added. Therefore, the pending claims are 21 – 36.
2. The rejections set forth in the previous Office Action are withdrawn due to the cancellations of claims 1 – 15. Rejections on newly added claims 21 – 36 are set forth below.
3. The affidavit under 37 CFR 1.132 filed November 21, 2002 is insufficient to overcome the rejection of claims 21 - 36 based upon Hobson and Carpenter et al. because: the affidavit fails to provide hard evidence which established the claimed product fills a long felt need or resulted in commercial success. While the Applicant sets forth multiple statements related to the products success and the Applicant's opinion why the product fills a long felt need, the Applicant fails to include any factual evidence which supports theses statements.

For example, while the Applicant does relate the products production as compared to similar products produced within the company there is no evidence to show how successful the product has been in the market as compared to all competitors in the field. The Applicant would need to produce evidence such as market share or other factual evidence which would show how the towel has succeeded verse all competitors. Further, it is noted that the Applicant bears the burden of proof of establishing a nexus between the claimed invention and evidence of commercial success and that the success is due to the claimed invention.

With respect to the Applicant's statement that the claimed subject matter solved a problem that was long standing in the art, there is no showing that others of ordinary skill in the

Art Unit: 1771

art were working on the problem and if so, for how long. In addition, there is no evidence that if persons skilled in the art who were presumably working on the problem knew of the teachings of the above cited references, they would still be unable to solve the problem. See MPEP § 716.04. While evidence of infringement can be used to establish that a long felt need was present the Applicant has only stated that competitors have tried to copy the invention without providing specific evidence detailing the actual infringement.

Thus, the affidavit submitted by the Applicant is not sufficient to overcome the art rejections since the Applicant has not provided factual evidence to clearly establish commercial success, unexpected results, or long felt need.

Election/Restrictions

4. Applicant's election of Group I, drawn to a woven textile with a graphic impression is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Drawings

5. The corrected or substitute drawings were received on November 25, 2002. These drawings are acceptable.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 21 – 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hobson (4,259,994) in view of Carpenter et al. (5,983,952).

The features of Hobson and Carpenter et al. were set forth in sections 12, 13, and 15 of the previous Office Action. Hobson discloses a patterned fabric comprising a printed design (abstract). Further, Hobson discloses that the fabric can have a design comprising, from one side to the other, a plain terry section, a floral border section, another plain terry section, another floral border section, and a final plain terry section (column 3, lines 3, lines 5 – 10). The two outer plain terry sections correspond to the Applicant's border. The final product will be blue with floral border sections on one side and gold with floral border section on the opposite side (column 3, lines 33 – 40). The floral designs are produced by printing the design onto the warp yarns prior to weaving (column 2, lines 23 – 25). Carpenter et al. is drawn to printed woven fabrics. Carpenter et al. discloses that many attempts have been made to incorporate printed patterns onto woven fabrics (column 1, lines 36 – 37). Further, the combinations of printed designs and weaving designs offers the ability to produce fabrics containing many different patterns and colors that have a unique and distinctive appearance (column 1, lines 40 – 43). Therefore, it would have been obvious to one of ordinary skill in the art to choose various printed designs, as well as choose where to place the printed image on the Hobson product to create various printed products which are visually and aesthetically pleasing to consumers. Thus, claims 21 – 36 are rejected.

Response to Arguments

Applicant's arguments filed November 20, 2002 have been fully considered but they are not persuasive. The Applicant argues that the prior art does not read on the Applicant's claimed printed towel since the yarns are printed prior to weave instead of after weaving. Even though product-by-process claims are limited by and defined by the process, determination of

Art Unit: 1771

patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same or an obvious variant from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the Applicant to show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289, 292 (Fed. Cir. 1983). Hence, in this case, the final product, i.e., a towel with a graphic impression, would be produced whether the yarns are printed before weave, or the fabric is woven and then printed. Therefore, the claims are rejected as set forth above.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 1771

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenna-Leigh Befumo whose telephone number is (703) 605-1170. The examiner can normally be reached on Monday - Friday (9:00 - 5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Jenna-Leigh Befumo
January 14, 2003



TERREL MORRIS
SUPERVISORY PATENT EXAMINER
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